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November 14, 2003

Mail Stop Appeal Brief - Patents  
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Re: **Application Serial No.:** 09/639,310  
**Confirmation No.:** 9530  
**Applicants:** Jay Paul Drummond, et al.  
**Title:** Automated Banking Machine  
Customer Profile Method  
**Docket No.:** D-1077+18

Sir:

Please find enclosed the Appeal Brief of Appellants pursuant to 37 C.F.R. § 1.192 in triplicate for filing in the above-referenced application.

It is believed that no extension of time is required. However, if such an extension is required then please consider this a petition therefore.

Please charge the fee required with this filing (\$330) and any other fee due to Deposit Account 09-0428.

Very truly yours,

Ralph E. Jocke  
Reg. No. 31,029

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: )  
                    **Jay Paul Drummond, et al.** )  
Serial No.:     **09/639,310** )  
Confirmation No.: **9530** )  
Filed:           **August 14, 2000** )  
For:             **Automated Banking Machine** )  
                    **Customer Profile Method** )

Art Unit 3628

Patent Examiner  
Debra F. Charles

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**BRIEF OF APPELLANTS  
PURSUANT TO 37 C.F.R. § 1.192**

Sir:

The Appellants hereby submit their Appeal Brief pursuant to 37 C.F.R. § 1.192, in triplicate, concerning the above-referenced Application.

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## **REAL PARTY IN INTEREST**

The Assignee of all right, title and interest to the above-referenced Application is Diebold, Incorporated, an Ohio corporation.

## **RELATED APPEALS AND INTERFERENCES**

Appellants believe that there are no related appeals or interferences pertaining to this matter.

## **STATUS OF CLAIMS**

Claims 1-24 are pending in the Application.

Claims 1-2, 5, 8-10, 12-13, 20-22 and 24 were rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Jheeta (US 5,619,558) in view of Bertram, et al. (US 6,049,812) (hereinafter "Bertram").

Claim 4 was rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Jheeta in view of Bertram and Akiyama, et al. (US 5,539,825) (hereinafter "Akiyama").

Claims 3, 6-7, 11, 14-18, and 23 were rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Jheeta in view of Bertram and Patterson, et al. (US 5,915,246) (hereinafter "Patterson").

Claim 19 was rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Jheeta in view of Bertram, Patterson, and Martin, Jr. et al. (US 6,304,860) (hereinafter "Martin").

These rejections were the only rejections present in the Office Action (“Action”) dated June 17, 2003, which was made Final. Appellants appeal each claim rejection, inclusive.

## **STATUS OF AMENDMENTS**

A final rejection was made June 17, 2003. No amendments to the claims were requested to be admitted after the final rejection.

## **SUMMARY OF INVENTION**

### Overview of an exemplary form of the Invention

An exemplary form of the invention is directed to a method of operating an ATM. The ATM includes a browser that can display web pages. The web pages include a plurality of ATM transaction options available to the ATM customer/user. A web page document is accessed from servers connected to a network, such as the Internet. An appropriate document is accessed based on the customer's “profile”. Respective customer profile properties (266) are assigned to respective customer accounts. A customer's account number can be determined by reading the customer's card at the ATM. Thus, the transaction options displayed to the ATM customer via a web page are determined by the customer's current profile properties. Examples of displayed transaction options include dispensing a “fast cash amount” and/or dispensing an amount of cash equal to the “last cash withdrawal amount.”

The customer profile information can be updated responsive to customer interaction with the ATM. Customer interaction may result in a modification to such properties as the preferred

language of the customer, fast cash preferences, and last withdrawal. For example, the fast cash preference amount (423) can be selected by the customer from a preferences setup page.

In the exemplary method, the ATM customer can select a displayed transaction option (e.g., the customer selects a cash withdrawal request corresponding to the displayed "fast cash amount"). The ATM performs the selected transaction (e.g., the ATM dispenses the amount of fast cash). The customer's profile is then updated responsive to the selected transaction. In the example, the "last cash withdrawal amount" property in the customer's stored profile is updated to reflect the latest cash withdrawal amount. Therefore, the customer's "last cash withdrawal amount" property is changed (if necessary) to equal the just dispensed amount of fast cash.

A plurality of customer profile properties can be included in a customer profile object (266). The customer profile object (266) is able to read and write information unique to a particular customer. The customer profile object (266) preferably interacts with one or more customer profile plug-ins to retrieve and update customer profile information stored in a remote data store. Figures 40-53 schematically show properties, events, and methods associated with ATM objects of the exemplary embodiment.

Figure 43 schematically represents an exemplary embodiment of a customer profile object (266) including a plurality of properties, such as a fast cash account (420) and amount (421), and a last withdrawal account (426) and amount (427). The fast cash account property (420) and the "fast cash amount" property (421) identify the banking account and the withdrawal amount that were displayed to the customer for the "fast cash amount" transaction option. The last cash withdrawal account property (426) and the "last cash withdrawal amount" property (427) identify the last account and the last amount that were dispensed to the customer in the last withdrawal

transaction. By using a customer profile object (266) to save the last cash withdrawal information, the ATM can present (the next time the customer accesses the ATM) an updated display to enable the customer to again withdraw the same amount of money. In addition, the customer profile object (266) may be used to retrieve and save other types of information in the data store. Such information may include marketing information associated with the particular customer. For example, the marketing information can be used to display at the ATM a web page having a targeted advertisement.

### **CONCISE STATEMENT OF THE ISSUES PRESENTED FOR REVIEW**

The questions presented in this appeal are:

- 1). Whether Appellants' claims 1-2, 5, 8-10, 12-13, 20-22 and 24 are unpatentable under 35 U.S.C. § 103(a) as being unpatentable over Jheeta in view of Bertram.
- 2). Whether Appellants' claim 4 is unpatentable under 35 U.S.C. § 103(a) as being unpatentable over Jheeta in view of Bertram and Akiyama.
- 3). Whether Appellants' claims 3, 6-7, 11, 14-18, and 23 are unpatentable under 35 U.S.C. § 103(a) as being unpatentable over Jheeta in view of Bertram and Patterson.
- 4). Whether Appellants' claim 19 is unpatentable under 35 U.S.C. § 103(a) as being unpatentable over Jheeta in view of Bertram, Patterson, and Martin.

## **GROUPING OF CLAIMS**

No groups of claims stand or fall together. Reasons are provided in the Argument section herein. The arguments presented provide reasons why the claims are separately patentable. Appellants present for each respective separate claim a corresponding respective separate argument as to why the claim is patentable over the rejection applied thereto. Each of Appellants' claims recites at least one element, combination of elements, or step not found or suggested in the applied references, which patentably distinguishes the claims.

The pending claims include four independent claims (claims 1, 9, 13, and 21). Claims 2-8 depend from independent claim 1. Claims 10-12 depend from independent claim 9. Claims 14-20 depend from independent claim 13. Claims 22-24 depend from independent claim 21. All pending claims 1-24 are reproduced in the Appendix.

## **ARGUMENT**

### **The Applicable Legal Standards**

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit evidence of nonobviousness. MPEP § 2142 (Eighth Edition, August 2001; Rev. 1, Feb. 2003).

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The evidence of record must teach or suggest the recited features. An assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

A determination of patentability must be based on evidence of record. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

#### **The Jheeta Reference**

Jheeta is directed to an ATM (14) that is operative to dispense to a customer a receipt (18) containing a transaction record, a promotion, and a telephone number for redeeming the promotion by the customer. When the customer calls the telephone number, a telephonic survey (28) is conducted and includes questions relating to products and services offered by a marketer.



Answers to the survey questions are stored in a customer profile in a computer database (30).

The customer profile is used to generate a target message specific to the customer which offers a specific product or service from the marketer based on the stored customer profile. The target message is then sent to the specific customer.

#### **The Bertram Reference**

Bertram is directed to a single browser that is operative to maintain multiple, concurrently active URLs within "marked tabs" (13) (Figure 4). This enables the browser to provide the functional emulation of a desktop working environment to the user.

#### **The Akiyama Reference**

Akiyama is directed to security enhancement for an electronic cashless transaction system. An IC card (11) is used as an electronic cashless transaction medium. The system enhances the transferring of money to/from the IC card.

#### **The Patterson Reference**

Patterson is directed to an automated teller machine (10) that is operated to provide, during the delays associated with authorizing and acting upon a user instruction, a sales presentation related to a financial product. The type of presentation is selected by matching a profile of the user, obtained from a central information store (20), with profiles of target customers for a number of financial products.

### **The Martin Reference**

Martin is directed to an electronic funds transfer methodology for providing access to a plurality of non-bank loan payment servicers through established ATM networks. The payment system is designed to allow a consumer to initiate an electronic transfer of funds from a primary bank transaction account (e.g., checking account, savings account) to a loan servicer to satisfy an outstanding consumer debt or payment obligation.

### **(iii) 35 U.S.C. § 103**

Appellants traverse the rejections on the grounds that Appellants' claims recite features and relationships which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants' invention. The features and relationships recited in Appellants' claims patentably distinguish over the applied references.

Appellants respectfully submit that none of the applied references, taken alone or in combination, teach or suggest the features and relationships that are specifically recited in the claims. The Office has not established a *prima facie* showing of obviousness. Additionally, even if it were somehow possible for the references to have disclosed certain features as alleged, it still would not have been obvious to one having ordinary skill in the art to have combined the references as alleged. Furthermore, even if it were somehow possible for the references to be combined as alleged, the resultant combination still would not have produced Appellants' claimed invention. That is, it would not have been obvious to one having ordinary skill in the art to have combined the references as alleged to have produced the recited invention. Thus, Appellants respectfully submit the rejections are improper and should be withdrawn.

**The Pending Claims Are Not Obvious Over  
Jheeta in view of Bertram**

Claims 1-2, 5, 8-10, 12-13, 20-22 and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jheeta in view of Bertram. These rejections are respectfully traversed.

**Claim 1**

Claim 1 is directed to a method of operating an automated transaction machine, including (a) reading customer identification information with a reading device in operative connection with an automated transaction machine; (b) accessing at least one customer profile value from at least one data store, responsive to the customer identification information; (c) generating at least one web page responsive to the at least one customer profile value; and (d) displaying the at least one web page at the machine through operation of a browser.

Neither Jheeta nor Bertram, taken alone or in combination, teach or suggest the recited method of claim 1. For example, neither Jheeta nor Bertram, taken alone or in combination, teach or suggest generating and displaying a browser web page at an automated transaction machine responsive to accessing a stored customer profile value, especially where the accessing is responsive to reading customer identification information with a reading device associated with the machine. The Action alleges that Jheeta discloses steps (a) and (b), but admits that Jheeta fails to disclose steps (c) and (d). The Action relies on Bertram as allegedly teaching steps (c) and (d).

Applicants respectfully submit that Bertram cannot overcome the admitted deficiencies of Jheeta as it does not disclose or suggest the recited features and relationships which are not found in Jheeta. For example, Bertram does not generate a web page responsive to a customer profile

value, especially a customer profile value accessed from a data store responsive to customer identification information read with a reading device in operative connection with an automated transaction machine. Furthermore, Bertram is non analogous to the art of automated transaction machines. The Action has not established that all of the recited features are known in the prior art. The Action lacks substantial evidence support. *In re Zurko*, supra. Thus, the Action does not factually support any *prima facie* conclusion of obviousness.

The Action admits that Jheeta does not teach or suggest generating a web page and displaying the web page at an automated transaction machine. The Action is silent as to how the system of Jheeta could be modified by the teachings of Bertram to achieve the recited invention. Nor is there any teaching or suggestion that Jheeta has the structural capability of generating a web page and displaying the web page at the automated transaction machine.

Nor does Jheeta need to generate and display a web page. The Action relies on Jheeta at col. 2, lines 20-50 as allegedly teaching steps (a) and (b). Apparently the Action views Jheeta's customer database (24) as constituting the recited customer profile value. However, the customer database (24) "contains customer identification information, the customer's personal identification number (PIN), and authorized financial transactions." This confidential data is conventionally internally used by a financial institution to check the PIN input by the customer against the assigned PIN, determine the corresponding customer account, and determine the permitted transactions assigned to that account. The Action is devoid of any teaching, suggestion, or motivation for having Jheeta display a web page relating to this internal confidential data. Thus, Jheeta's customer database (24) cannot constitute the recited customer profile value.

Jheeta's marketing method requires that the customer call a phone number (18p) so that survey information can be obtained. Jheeta desires that the customer be provided the phone number in a customer-friendly format that enables the customer to easily take and hold the phone number. Thus, Jheeta optimally provides the phone number in a printed format on an item (e.g., the paper receipt 18) with which the customer is familiar and needs. The paper receipt (18) includes thereon a promotion (18p) (e.g., a coupon of monetary value) in order to attract the customer (col. 2, line 64 to col. 3, line 3). Neither reference includes any suggestion, teaching, or motivation to modify the ATM of Jheeta to include the ability to present the phone number or any promotion via a web page instead of the explicitly taught receipt method.

Even if it were somehow possible, it would not have been obvious to have modified Jheeta to have provided the phone number or promotion to the customer via a web page instead of the paper receipt. Jheeta would lose the ability to attract or entice customers with a coupon of monetary value provided on the paper receipt. Even if a customer was somehow interested in obtaining (without a monetary incentive) the phone number from a web page, an additional burden would be placed upon the customer to obtain the phone number. For example, additional materials (e.g., paper, pen) and labor (e.g., writing the phone number) would be required. Further, the additional time needed to obtain the phone number would be detrimental to other customers waiting to use the machine. The alleged modification adversely departs from the explicitly disclosed and desired operation and ability of Jheeta.

Therefore, even if it were somehow possible (which it isn't) for Bertram to teach the recited features admitted as absent in Jheeta, the alleged modification to Jheeta would destroy Jheeta's explicitly taught structure and operation. However, an obviousness rejection cannot be

based on a combination of features if making the combination would result in destroying the utility of the device shown in the prior art reference. Note *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988). One having ordinary skill in the art would not have found it obvious to have modified Jheeta with the alleged teaching of Bertram to have produced the recited invention.

#### Additional Comments

The Action (on page 2) states that Bertram discloses "a browser and URL manager for computers on networked systems. ATM systems are networked. This enables the ATM to verify the user against the database. Any computer system with a display feature such as those typical of ATMs are browser and internet capable if the browser software is installed in the computer network."

The Appellants respectfully disagree. The Office confuses a proprietary ATM network with the Internet network. ATMs have conventionally operated within their own proprietary network long before the advent of the Internet and browser technology. A proprietary network has been used for purposes of security and reliability. The Action has presented no evidence of an ATM network comprising the Internet network instead of a conventional proprietary network. It is unclear how simply installing browser software in a proprietary setup ATM network (as alleged) would enable the method of claim 1 to be performed. The Action has not provided any evidence supporting the allegation that "if" browser software was somehow installed in a conventional ATM network then the ATM transactions, such as verifying a user against a database, would be carried out on the Internet and web pages would be generated and displayed at the ATM. Further, the rejection relies on the uncertainty of "if" browser software can be

installed in Jheeta. The rejection is devoid of any teaching, suggestion, or motivation for modifying Jheeta as alleged.

Furthermore, Jheeta teaches a "conventional" ATM (14) which includes conventional components (14a, 14b, 14c, 14d) and is in a "conventional ATM network" (col. 2, lines 24-27 and 32-33). There is no evidence that Jheeta's conventional ATM network (20), like a conventional proprietary ATM network, requires a browser to operate. Nor has any motivation been provided to modify Jheeta's desired conventional ATM network, especially in light of Bertram's non analogous teaching. Bertram is non analogous to the art of ATMs, especially ATMs on a conventional proprietary ATM network that do not require a browser and/or the Internet. Nor has any evidence been provided that the conventional system of Jheeta is structurally and functionally capable of being modified as alleged to carry out the recited method, especially without destroying Jheeta's desired conventional ATM network (20). The Office has not established a *prima facie* showing of obviousness. Again, it would not have been obvious to one having ordinary skill in the art to have modified Jheeta with the teaching of Bertram to have produced the recited method.

The Action (on page 3) alleges that Bertram generates a web page responsive to a customer profile value accessed from a data store because the browser can open with a pre-established user selected preference stored in a data store. The Appellants respectfully disagree. The Action's relied upon section of Bertram indicates that "the content window may be varied by the user and other views may be chosen" (col. 7, lines 26-27). However, this ability does not appear pertinent to "generating" a web page, but (at best) rather changing the view of the web page after the web page has already been displayed. Bertram does not teach or suggest the

recited features, relationships, or steps. Claim 1 recites that a customer profile value is accessed from at least one data store responsive to read customer identification information (in association with operating an automated transaction machine). Bertram does not access a stored customer profile value in the manner recited. Where does Bertram link accessing a stored customer profile value responsive to reading (with a reading device) customer identification information? Where does Bertram link generating a web page responsive to accessing a stored customer profile value (which accessing is responsive to reading customer identification information)? Bertram is not concerned with operating an automated transaction machine or reading customer ID. It follows that Bertram cannot generate and display a web page in the manner recited. Thus, modification of Jheeta with the teaching of Bertram could not have resulted in the recited invention.

The attempts to modify Jheeta are clearly attempts at hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 22 USPQ2d 1780 (Fed. Cir. 1992). The rejection, which lacks the necessary evidence and rationale, is based on knowledge gleaned only from Appellants' disclosure. Thus, Appellants' respectfully submit that the 35 U.S.C. § 103(a) rejection should be withdrawn.

**Bertram does not constitute prior art to the claimed invention**

Appellants respectfully submit that Bertram is not available prior art. The present invention claims benefit to the November 27, 1996 filing date of provisional application 60/031,956. Bertram has a filing date of November 18, 1996. Appellants reduced to practice their invention shown in the priority application prior to the filing date of Bertram and submit that the approximately nine (9) day difference in time falls within the reasonable time



period permitted for preparing and filing the instant patent application (MPEP § 2142, Eighth Edition, August 2001; Rev. 1, Feb. 2003; pages 2100-112 and 2100-114). Provisional application 60/031,956 included 37 pages of Specification; 30 claims; an Abstract; and 24 sheets of drawings. The nine (9) days falls within a time period of reasonable "attorney-diligence" and "engineering-diligence", which does not require the (many) inventors or the attorney to drop all other work and concentrate on the particular invention. *Bey v. Kollonitsch*, 866 F.2d 124, 231 USPQ 967, 970 (Fed. Cir. 1986); *Emery v. Ronden*, 188 USPQ 264, 269 (Bd. Pat. Inter. 1974); and *Keizer v. Bradley*, 270 F.2d 396, 397, 123 USPQ 214, 216 (CCPA 1959). Thus, Appellants respectfully submit that Bertram does not constitute prior art in regard to the recited invention.

Appellants "may overcome a 35 U.S.C. § 103 rejection based on a combination of references by showing completion of the invention by applicant prior to the effective date of any of the references" (MPEP § 715.02; Eighth Edition, August 2001; Rev. 1, Feb. 2003). It follows that the rejections relying on Bertram (as available prior art) are not valid. The 35 U.S.C. § 103(a) rejection of claim 1 (and all the rejections) involve Bertram. For these additional reasons it is respectfully submitted that the rejection of claim 1 (and all of the claim rejections) should be withdrawn.

## **Claim 2**

Claim 2 depends from claim 1. The references, taken alone or in combination, further do not teach or suggest modifying at least one customer profile value in the data store responsive to an input received from an operator of the automated transaction machine.

The Action alleges that Jheeta (at col. 1, lines 40-60, col. 2, lines 20-50, and col. 3, lines 35-67) discloses "modifying the at least one customer profile value in the data store responsive to

the input." The Appellants respectfully disagree. The Action's relied upon sections of Jheeta relate to a telephone survey. The survey answers are input into a customer profile database (30) by the service center (28). However, the recited "input" of claim 2 is received from the operator of the automated transaction machine. Where do the references enable an operator of an automated transaction machine to modify (via an input) a customer profile value? Where do the references permit a customer of an automated transaction machine to modify that customer's profile?

The Office has not established a *prima facie* showing of obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified Jheeta with the teaching of Bertram to have produced the recited method.

#### **Claim 5**

Claim 5 depends from claim 2. The references, taken alone or in combination, further do not teach or suggest generating a web page responsive to a customer profile value accessed from a data store responsive to customer identification information read from a card. It follows that alleged modification of Jheeta would not have resulted in use of a card reader device in the manner recited.

#### **Claim 8**

Claim 8 depends from claim 1. The references, taken alone or in combination, further do not teach or suggest computer readable media having computer readable instructions operative to cause at least one computer to carry out the recited steps. The Action relies on Jheeta at col. 1, lines 40-60 and col. 2, lines 1-60 as allegedly teaching the recited computer readable media. However, the relied upon sections of Jheeta do not teach or suggest computer readable media that

is operative to cause the recited method to be performed. It would not have been obvious to one having ordinary skill in the art to have modified Jheeta with the teaching of Bertram to have produced the recited invention.

**Claim 9**

Claim 9 is directed to a method comprising (a) reading an account number from a card with a card reading device of an automated transaction machine; (b) accessing a plurality of customer profile values that correspond to the account number; (c) displaying a web page in a browser with the automated transaction machine, wherein the web page includes a plurality of selectable options for performing a transaction with the automated transaction machine, wherein at least one of the selectable options is produced responsive to at least one of the accessed customer profile values; (d) receiving an input that corresponds to a selected one of the selectable options with an input device; and (e) performing the transaction with the automated transaction machine responsive to the selected one of the selectable options.

Note Appellants' remarks in support of the patentability of claim 1. Neither Jheeta nor Bertram, taken alone or in combination, teach or suggest the recited method of claim 9. The Action (on page 4) admits that Jheeta does not teach or suggest displaying a web page at an automated transaction machine through operation of a browser. As discussed previously with respect to claim 1, neither Jheeta nor Bertram, taken alone or in combination, teach or suggest displaying a web page at an automated transaction machine. Furthermore, neither Jheeta nor Bertram, taken alone or in combination, teach or suggest displaying a web page that includes a plurality of selectable options for performing a transaction with the automated transaction machine. Nor do the references teach or suggest that at least one of the selectable options is

produced responsive to at least one accessed customer profile value. Where do the references, taken alone or in combination, teach or suggest displaying a selectable option (included in a web page in a browser with an automated transaction machine) responsive to an accessed customer profile value (which corresponds to an account number read from a card)? Nor do the references teach or suggest performing a transaction with an automated transaction machine responsive to a selected option received by input with an input device.

The Action has not established that all of the recited features are known in the prior art. The Action lacks substantial evidence support. *In re Zurko*, supra. Thus, the Action does not factually support any *prima facie* conclusion of obviousness. It would not have been obvious to one having ordinary skill in the art to have modified Jheeta with the teaching of Bertram to have produced the recited method of claim 9.

#### **Claim 10**

Claim 10 depends from claim 9. The references, taken alone or in combination, further do not teach or suggest modifying at least one customer profile value in the data store responsive to an option selected (via an input) from a plurality of selectable options in a web page displayed with an automated transaction machine. Where do the references permit modification to a customer profile responsive to a selected option input? Also, note Appellants' remarks in support of the patentability of claim 2. The Office has not established a *prima facie* showing of obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified Jheeta with the teaching of Bertram to have produced the recited method.

**Claim 12**

Claim 12 depends from claim 9. The references, taken alone or in combination, further do not teach or suggest computer readable media having computer readable instructions operative to cause at least one computer to carry out the recited steps. It would not have been obvious to one having ordinary skill in the art to have modified Jheeta with the teaching of Bertram to have produced the recited invention.

**Claim 13**

Claim 13 is directed to a method comprising (a) receiving at least one customer identification value with an automated transaction machine; (b) accessing a customer profile from a data store, wherein the customer profile corresponds to the customer identification value, wherein the customer profile includes a customer type value; and (c) displaying a web page in a browser of the automated transaction machine, wherein the web page is loaded responsive to the customer type value.

Note Appellants' remarks in support of the patentability of claim 1. Neither Jheeta nor Bertram, taken alone or in combination, teach or suggest the recited method of claim 13. The Action (on page 4) admits that Jheeta does not teach or suggest displaying a web page at an automated transaction machine through operation of a browser. As discussed previously with respect to claim 1, neither Jheeta nor Bertram, taken alone or in combination, teach or suggest displaying a web page in a browser of an automated transaction machine. Furthermore, neither Jheeta nor Bertram, taken alone or in combination, teach or suggest that the web page is loaded responsive to a customer type value included in an accessed customer profile (which corresponds to a customer identification value received with an automated transaction machine). Where do

the references link a web page display (at an automated transaction machine) to the type of customer? The Office has not established a *prima facie* showing of obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified Jheeta with the teaching of Bertram to have produced the recited method of claim 13.

#### **Claim 20**

Claim 20 depends from claim 13. The references, taken alone or in combination, further do not teach or suggest computer readable media having computer readable instructions operative to cause at least one computer to carry out the recited steps. It would not have been obvious to one having ordinary skill in the art to have modified Jheeta with the teaching of Bertram to have produced the recited invention.

#### **Claim 21**

Claim 21 is directed to a method comprising (a) receiving a customer identity value associated with a consumer using an ATM; (b) accessing a customer profile responsive to the customer identity value; (c) selecting a targeted advertisement responsive to the customer profile; and (d) displaying a web page in a browser of the ATM, wherein the web page includes the targeted advertisement.

Note Appellants' remarks in support of the patentability of claim 1. Neither Jheeta nor Bertram, taken alone or in combination, teach or suggest the recited method of claim 21. The Action (on page 4) admits that Jheeta does not teach or suggest displaying a web page at an automated transaction machine through operation of a browser. Bertram is non analogous to the art of ATMs. Neither Jheeta nor Bertram, taken alone or in combination, teach or suggest displaying a web page in a browser of an ATM. Furthermore, neither Jheeta nor Bertram, taken

alone or in combination, teach or suggest displaying a targeted advertisement via a browser web page at an ATM. It follows that the combined teachings could not have resulted in the recited invention.

The Action has failed to show that all of the features and relationships recited in claim 21 are known in the prior art. Thus, the Office has not met its burden of establishing *prima facie* obviousness. Even if all of the features recited in the claim could have been found in the prior art by the Office (which it hasn't), the Action would still be absent a specific teaching, suggestion, or motivation in the prior art to modify Jheeta in the manner alleged to support a rejection on the basis of obviousness. Again, the Office has not met its burden of establishing obviousness. Nevertheless, even if it were somehow possible (which it isn't) for the Jheeta to have been structurally and functionally modified with the teaching of Bertram as alleged, the resultant combination still would not have produced Appellants' claimed invention. That is, it would not have been obvious to one having ordinary skill in the art to have modified Jheeta as alleged to have produced the recited invention of claim 21. Thus, Appellants respectfully submit the rejection is improper and should be withdrawn.

#### **Claim 22**

Claim 22 depends from claim 21. The references, taken alone or in combination, further do not teach or suggest displaying a promotion for a financial institution in a web page at an ATM to a consumer determined not to be a customer of the financial institution. The relied upon section of Jheeta relates to a telephone survey. The Appellants respectfully submit that the Office misinterprets the claim. Claim 22 recites that step (e) is prior to step (c). The Office has not established a *prima facie* showing of obviousness.

**Claim 24**

Claim 24 depends from claim 21. The references, taken alone or in combination, further do not teach or suggest computer readable media having computer readable instructions operative to cause at least one computer to carry out the recited steps. It would not have been obvious to one having ordinary skill in the art to have modified Jheeta with the teaching of Bertram to have produced the recited invention.

**The Pending Claims Are Not Obvious Over  
Jheeta in view of Bertram and Akiyama**

Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Jheeta in view of Bertram and Akiyama. This rejection is respectfully traversed.

**Claim 4**

Claim 4 depends from claim 2. The Action (at paragraph number 6) admits that Jheeta/Bertram does not teach or suggest a smart card. The Action relies on Akiyama as teaching a smart card. However, where does Akiyama teach or suggest modifying a customer profile value in a data store including a smart card, especially where the modification is responsive to an input received from an operator of the automated transaction machine? It follows that the references, taken alone or in combination, do not teach or suggest that the data store includes a smart card in the manner recited. It further follows that the Office has not established a *prima facie* showing of obviousness.



**The Pending Claims Are Not Obvious Over  
Jheeta in view of Bertram and Patterson**

Claims 3, 6-7, 11, 14-18, and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jheeta in view of Bertram and Patterson. These rejections are respectfully traversed.

**Claim 3**

Claim 3 depends from claim 2. The Action (at paragraph number 7) admits that Jheeta/Bertram does not teach or suggest a data store including a remote database. The Action relies on Patterson as teaching a remote database on a host system. However, where does Patterson teach or suggest generating a web page responsive to a customer profile value accessed from a data store having a remote database? It would not have been obvious to one having ordinary skill in the art to have modified Jheeta/Bertram with the alleged teaching of Patterson to have produced the recited invention.

**Claim 6**

Claim 6 depends from claim 2. The Action (at paragraph number 7) admits that Jheeta/Bertram does not teach or suggest a customer profile value that is representative of a preferred language. The Action alleges that Patterson discloses "customer profile value and customer type along with option selection." Regardless, where does Patterson teach or suggest a customer profile value that is representative of a preferred language? Where does Patterson teach or suggest (or mention) different languages? Where do the references, taken alone or in combination, teach or suggest the ability to generate a web page in a preferred language? Furthermore, where do the references, taken alone or in combination, teach or suggest the ability

of the machine operator to modify the preferred language via an input? Again, the Office has not established a *prima facie* showing of obviousness.

#### **Claim 7**

Claim 7 depends from claim 2. The Action (at paragraph number 7) admits that Jheeta/Bertram does not teach or suggest a customer profile value that is representative of a fast cash amount. The Action alleges that Patterson discloses "customer profile value and customer type along with option selection." Regardless, where does Patterson teach or suggest a customer profile value that is representative of a fast cash amount? Patterson teaches of an ATM that predicts the transaction most likely to be requested by a user, and then presents a relevant message. However, the evidence of record does not teach or suggest that in Patterson the transaction most likely to be requested was a fast cash amount. An assertion not based on any evidence in the record lacks substantial evidence support. The determination of patentability must be based on evidence of record. *In re Zurko*, supra. *In re Lee*, supra.

The references, taken alone or in combination, further do not teach or suggest the ability of the machine operator to modify the fast cash amount via an input. Where do the references teach or suggest these features? Again, the Office has not established a *prima facie* showing of obviousness.

#### **Claim 11**

Claim 11 depends from claim 10. The Action (at paragraph number 7) admits that Jheeta/Bertram does not teach or suggest a customer profile value that is representative of a last withdrawal amount. The Action alleges that Patterson discloses "customer profile value and customer type along with option selection." Regardless, where does Patterson teach or suggest a

customer profile value that is representative of a last withdrawal amount? Patterson teaches of an ATM that predicts the transaction most likely to be requested by a user, and then presents a relevant message. However, the evidence of record does not teach or suggest that in Patterson the transaction most likely to be requested was the last withdrawal amount. An assertion not based on any evidence in the record lacks substantial evidence support. The determination of patentability must be based on evidence of record. *In re Zurko*, supra. *In re Lee*, supra.

Further, where do the references, taken alone or in combination, teach or suggest the ability to generate a web page having an option to dispense the last withdrawal amount? Where do the references teach or suggest the ability to modify the last withdrawal amount via an input? Where do the references teach or suggest these features? Again, the Office has not established a *prima facie* showing of obviousness.

#### **Claim 14**

Claim 14 depends from claim 13. The Action (on page 5, last paragraph) admits that Jheeta/Bertram does not teach or suggest that a customer type corresponds to a servicer of automated transaction machines. The Action alleges that Patterson discloses "option selection based on customer profile." Regardless, where does Patterson teach or suggest a customer type corresponding to a servicer of automated transaction machines. The references, taken alone or in combination, do not teach or suggest displaying an automated transaction machine web page that includes a plurality of selectable servicer options for servicing the automated transaction machine. Where do the references link machine servicer options to web page display at an automated transaction machine? Where do the references even mention a servicer of an automated transaction machine? The Office has not established a *prima facie* showing of

obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified Jheeta/Bertram with the alleged teaching of Patterson to have produced the recited method.

#### **Claim 15**

Claim 15 depends from claim 14. The Action (on page 6, first paragraph) admits that Jheeta/Bertram does not teach or suggest that a customer type corresponds to a consumer. The references, taken alone or in combination, do not teach or suggest displaying a web page that includes a plurality of selectable transaction options for performing transactions with the automated transaction machine when the customer type corresponds to a consumer. It would not have been obvious to one having ordinary skill in the art to have modified Jheeta/Bertram in the manner alleged to have produced the recited method.

#### **Claim 16**

Claim 16 depends from claim 15. The Action admits that Jheeta/Bertram does not teach or suggest the recited features of claim 16. The Action (on page 6, last paragraph) refers to claim 16, but not the actual steps (d) and (e) recited therein. That is, the Action is silent as to the recited steps (d) and (e) of claim 16. Nevertheless, the references, taken alone or in combination, do not teach or suggest dispensing an amount of cash with a cash dispenser device responsive to receiving an input that corresponds to a selectable transaction option displayed on a web page at an automated transaction machine. It follows that the Office has not established a *prima facie* showing of obviousness.

### **Claim 17**

Claim 17 depends from claim 13. The Action (on page 6, fourth paragraph) admits that Jheeta/Bertram does not teach or suggest updating a customer profile responsive to received input. The Action relies on "Official notice that it is old and well known in the computer art to get the advantage of providing customers with selectable options that automatically builds the customer's profile in order to present the customer with relevant selectable options upon subsequent ATM use." The Action then alleges that it would have been obvious to include customer selectable options in which the actual selected option becomes a part of the customers' stored profile.

The Appellants respectfully disagree. The evidence of record does not teach or suggest the recited features. The determination of patentability must be based on evidence of record. An assertion of basic knowledge and common sense (which is the current situation) not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, supra. *In re Lee*, supra. The rejection is based on a mere assertion (i.e., Official notice), not evidence of record. Thus, the rejection is not legally valid.

Nevertheless, the references, taken alone or in combination, do not teach or suggest updating customer profile data responsive to a received input corresponding to a selectable transaction option included in a web page displayed at an ATM. The Office has not established a *prima facie* showing of obviousness.

### **Claim 18**

Claim 18 depends from claim 13. The Action (on page 5, last paragraph) admits that Jheeta/Bertram does not teach or suggest the recited features of claim 18. The Action alleges

obviousness based on the teaching of Patterson. However, Patterson does not teach or suggest that when a customer type corresponds to a first type of customer, the displayed web page includes a first option to perform a first transaction with the automated transaction machine, and when the customer type corresponds to a second type of customer, the displayed web page does not include the first option. Where do the references teach or suggest displaying a web page with a first transaction option to a first type of customer, and displaying a web page without the first transaction option to a second type of customer? It follows that it would not have been obvious to one having ordinary skill in the art to have modified Jheeta/Bertram in the manner alleged to have produced the recited method.

### **Claim 23**

Claim 23 depends from claim 21. The Action (on page 6, fourth paragraph) admits that Jheeta/Bertram does not teach or suggest updating a customer profile responsive to received input. The Action relies on "Official notice that it is old and well known in the computer art to get the advantage of providing customers with selectable options that automatically builds the customer's profile in order to present the customer with relevant selectable options upon subsequent ATM use." The Action then alleges that it would have been obvious to include customer selectable options in which the actual selected option becomes a part of the customers' stored profile.

The Appellants respectfully disagree. The evidence of record does not teach or suggest the recited features. The determination of patentability must be based on evidence of record. An assertion of basic knowledge and common sense (which is the current situation) not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, supra. *In re Lee*, supra.

The rejection is based on a mere assertion (i.e., Official notice), not evidence of record. Thus, the rejection is not legally valid.

Nevertheless, the references, taken alone or in combination, do not teach or suggest updating a customer profile responsive to a received input corresponding to a selectable option included in a targeted advertisement displayed in a web page at an ATM. The Office has not established a *prima facie* showing of obviousness.

**The Pending Claims Are Not Obvious Over  
Jheeta in view of Bertram, Patterson, and Martin**

Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Jheeta in view of Bertram, Patterson, and Martin. This rejection is respectfully traversed.

**Claim 19**

Claim 19 depends from claim 18. The Action (on page 7) admits that Jheeta/Bertram/Patterson does not teach or suggest that the first transaction corresponds to bill payment. The Action relies on Martin as teaching ATM transactions that permit bill payment. The Action then alleges that it would have been obvious to have even further modified Jheeta/Bertram/Patterson to have included using an ATM screen to select bill payment.


The Appellants respectfully disagree. Martin does not teach or suggest that when a customer type corresponds to a first type of customer, a displayed web page includes an option to pay a bill with the automated transaction machine, and when the customer type corresponds to a second type of customer, the displayed web page does not include the option. Where does Martin teach or suggest displaying a web page? Where do the references teach or suggest

displaying a web page with a bill payment option to a first type of customer, and displaying a web page without the bill payment option to a second type of customer? The Office has not established a *prima facie* showing of obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified Jheeta/Bertram/Patterson in the manner alleged to have produced the recited method.

### CONCLUSION

Each of Appellants' pending claims specifically recites features, relationships, and steps that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any teaching, suggestion, or motivation for combining features of the applied art so as to produce the recited invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,



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## **APPENDIX**

### **CLAIMS**

1. A method of operating an automated transaction machine comprising:
  - a) reading customer identification information with a reading device in operative connection with an automated transaction machine;
  - b) accessing at least one customer profile value from at least one data store, responsive to the customer identification information;
  - c) generating at least one web page responsive to the at least one customer profile value; and
  - d) displaying the at least one web page at the machine through operation of a browser.
2. The method according to claim 1, further comprising:
  - e) receiving an input from an operator of the automated transaction machine; and
  - f) modifying the at least one customer profile value in the data store responsive to the input.

3. The method according to claim 2, wherein the data store includes a remote database.
4. The method according to claim 2, wherein the data store includes a smart card.
5. The method according to claim 2, wherein in step (a) the reading device includes a card reader device, and wherein the customer identification information is read from a card.
6. The method according to claim 2, wherein the customer profile value is representative of the preferred natural language of the customer, wherein the web page is generated in a language that corresponds to the value, wherein the input is representative of a different value for the preferred natural language of the customer.
7. The method according to claim 2, wherein the customer profile value is representative of a fast cash amount, wherein the web page includes a selectable option which corresponds to having the automated transaction machine dispense an amount of cash that is equal to the fast cash amount, wherein step (f) includes modifying the fast cash amount.
8. Computer readable media having computer readable instructions embodied thereon, the computer readable instructions operative to cause at least one computer to carry out the method steps recited in claim 1.
9. A method comprising:

- a) reading an account number from a card with a card reading device of an automated transaction machine;
- b) accessing a plurality of customer profile values that correspond to the account number;
- c) displaying a web page in a browser with the automated transaction machine, wherein the web page includes a plurality of selectable options for performing a transaction with the automated transaction machine, wherein at least one of the selectable options is produced responsive to at least one of the accessed customer profile values;
- d) receiving an input that corresponds to a selected one of the selectable options with an input device; and
- e) performing the transaction with the automated transaction machine responsive to the selected one of the selectable options.

10. The method according to claim 9, further comprising:

- f) modifying at least one of the accessed customer profile values in the data store responsive to the selected option.

11. The method according to claim 10, wherein the customer profile values include a last withdrawal amount representative of a previously withdrawn amount of cash, wherein one of the selectable options corresponds to a dispensing of an amount of cash equal to the last withdrawal amount, wherein step (e) includes dispensing of a selected amount of cash with a cash dispenser device, and wherein step (f) includes modifying the last withdrawal amount with a value that corresponds to the selected amount of cash.
12. Computer readable media having computer readable instructions embodied thereon, the computer readable instructions operative to cause at least one computer to carry out the method steps recited in claim 9.
13. A method comprising:
  - a) receiving at least one customer identification value with an automated transaction machine;
  - b) accessing a customer profile from a data store, wherein the customer profile corresponds to the customer identification value, wherein the customer profile includes a customer type value; and
  - c) displaying a web page in a browser of the automated transaction machine, wherein the web page is loaded responsive to the customer type value.

14. The method according to claim 13, wherein when the customer type corresponds to a servicer of automated transaction machines, the web page includes a plurality of selectable servicer options for servicing the automated transaction machine.
15. The method according to claim 14, wherein when the customer type corresponds to a consumer, the web page includes a plurality of selectable transaction options for performing transactions with the automated transaction machine.
16. The method according to claim 15, further comprising:
  - d) receiving an input that corresponds to one of the selectable transaction options;  
and
  - e) dispensing an amount of cash with a cash dispenser device responsive to the input.
17. The method according to claim 13, wherein the web page includes a plurality of selectable transaction options for performing transactions with the automated transaction machine, and wherein the method further comprises:
  - d) receiving an input that corresponds to one of the selectable transaction options;  
and
  - e) updating the customer profile data responsive to the input.

18. The method according to claim 13, wherein when the customer type corresponds to a first type of customer, the web page includes a first option to perform a first transaction with the automated transaction machine, wherein when the customer type corresponds to a second type of customer, the web page does not include the first option.
19. The method according to claim 18, wherein the first transaction corresponds to bill payment.
20. Computer readable media having computer readable instructions embodied thereon, the computer readable instructions operative to cause at least one computer to carry out the method steps recited in claim 13.
21. A method comprising:
  - a) receiving a customer identity value associated with a consumer using an ATM;
  - b) accessing a customer profile responsive to the customer identity value;
  - c) selecting a targeted advertisement responsive to the customer profile; and
  - d) displaying a web page in a browser of the ATM, wherein the web page includes the targeted advertisement.

22. The method according to claim 21, further comprising prior to step (c):
- e) determining if the consumer is a customer associated with a financial institution, wherein if the consumer is determined not to be a customer of the financial institution, the targeted advertisement includes a promotion for the financial institution.
23. The method according to claim 21, wherein the targeted advertisement includes at least one selectable option, wherein the method further comprises:
- (e) receiving an input from the consumer that corresponds to the selectable option; and
  - (f) updating the customer profile responsive to the input.
24. Computer readable media having computer readable instructions embodied thereon, the computer readable instructions operative to cause at least one computer to carry out the method steps recited in claim 21.